

REMARKS

Claims 1-30 were previously pending in this application. Claims 12-18 are allowed. Claims 1, 4-9, 19 and 22-27 were rejected and claims 2, 3, 10, 11, 20, 21 and 28-30 were objected to.

5 Claims 19 and 20 are presently amended and claims 31 and 32 are newly added. Applicants respectfully request re-examination and reconsideration of claims 1-11 and 19-30 and allowance of each of presently pending claims 1-11 and 19-32 (as above, claims 12-18 have already been allowed).

I. **Allowable Subject Matter**

10 Applicants thank the Examiner for indicating, in paragraph 4, that claims 12-18 have been allowed.

II. **Claim Rejections Under 35 U.S.C. §112**

15 In the Office Action, specifically in paragraph 1, claims 19-30 were rejected under 35 U.S.C. §112, second paragraph. These claim rejections are overcome for reasons set forth below.

20 Original claims 19 and 20 included the phraseology "a means of...". Each instance of this language in claims 19 and 20 has been amended to correctly recite "means for...". Claims 21-30 depend, directly or indirectly from independent claim 19 and did not include such language. Claims 19 and 20 now comply with the requirements of 35 U.S.C. §112, second paragraph and the rejection of claims 19 and 20 should be withdrawn. Since claims 21-30 depend from amended independent claim 19 and also now comply with the requirements of 35 U.S.C. §112, second paragraph,

the rejection of claims 21-30 under 35 U.S.C. §112, second paragraph, should also be withdrawn.

III. Claim Objections

In paragraph 4, page 4 of the Office Action, claims 2, 3, 10, 11, 20, 21 and 28-30 were objected to as being dependent upon a rejected base claim but it was indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Previously pending claim 2 depended from claim 1 and the features of previously pending claim 2 and base claim 1 have been combined and rewritten as new claim 31.

Claim 31 therefore is an allowable form.

Previously pending claim 20 depended from claim 19 and the features of previously pending claim 20 and its base claim – claim 19, have been combined and rewritten as new claim 32. Claim 32 therefore is an allowable form.

Claims 3, 10 and 11 depend from claim 1 which is allowable for reasons set forth below and claims 21 and 28-30 depend from claim 19 which is in allowable form for reasons set forth below. As such, the claim objections under this paragraph should each be withdrawn.

IV. Claim Rejections Under 35 U.S.C. §102

In paragraph 2 of the Office Action, claims 1, 4, 5, 7-9, 19, 22, 23 and 25-27 were rejected under 35 U.S.C. §102(b) as being anticipated by Kono (U.S. Pat. #6,392,944). Applicants respectfully submit that these claim rejections are overcome based on the reasons set forth below.

Among the claims rejected under this section, claims 1 and 19 stand as the independent claims. As above, independent claim 19 has been amended to comply with the requirements of 35 U.S.C. §112. Independent claim 1 recites the feature of:

5 selecting a set of switchable capacitors from said plurality of switchable capacitors to thereby connect said optimal capacitance value from said upper voltage node to said ground.

Independent claim 19 recites the feature of:

10 means for selecting a set of said switchable capacitors from said plurality of switchable capacitors to thereby connect said optimal capacitance value from said upper voltage node to said ground.

An aspect of each of independent claims 1 and 19 is the *selection* of a set of switchable capacitors from a plurality of switchable capacitors. The application of optimal capacitance value from the upper voltage node to ground is accomplished by this selection. As in the specification on page 11, lines 17-18, "each switchable
15 capacitor is controlled separately". Furthermore, the "decoupling controller 90 selectively asserts or de-asserts the control signals CC1 104, CC2, 106, CC3 108 to thereby selectively connect capacitors" The cited reference of Kono, in contrast, does not teach or suggest the selection of a set of switchable capacitors from a plurality of switchable capacitors to provide an optimal capacitance between an upper voltage
20 node and ground. The control circuit 470 of Kono "controls the capacitance value of the variable decoupling capacitor 460", Kono, column 20, lines 58 – 59. In further detailed descriptions of decoupling capacitor 460, Kono provides that a signal is provided to every capacitor that forms the entity disclosed as decoupling capacitor 460. In other words, each of the capacitors is "selected" in Kono. Kono therefore does not teach or
25 suggest selecting a set of switchable capacitors from a plurality of switchable

capacitors. Therefore independent claims 1 and 19 recite features that distinguish applicant's invention from Kono and as such, the rejection of claims 1 and 19 under 35 U.S.C. §102(b), should be withdrawn. Claims 4, 5, and 7-9 depend from claim 1 and claims 22, 23 and 25-27 depend from claim 19 and each therefore are distinguished from Kono and the rejection of these claims under 35 U.S.C. §102(b) should similarly be withdrawn.

V. Claim Rejections Under 35 U.S.C. §103

In the Office Action, specifically in paragraph 3, claims 6 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kono in view of the Examiner's statement that making the capacitors using MOS devices would have been obvious. Without addressing the obviousness allegation of the Examiner, applicants submit that the use of capacitors using MOS devices does not make up for the above-stated shortcomings of Kono. Claims 6 and 24, which depend from claims 1 and 19 respectively, are therefore distinguished from the reference of KONO in view of the Examiner's comments.

The rejection of claims 6 and 26 under 35 U.S.C. §103(a) should therefore be withdrawn.

CONCLUSION

Based on the foregoing, each of claims 1-32 is in allowable form and the application is therefore in condition for allowance, which action is respectfully and expeditiously requested.

Respectfully submitted,

Dated: January 6, 2005


Mark J. Marcelli, Reg. No. 36,593
Attorney for Applicants

DUANE MORRIS LLP
101 West Broadway, Suite 900
San Diego, CA 92101
619.744.2200 Main Phone
619.744.2201 Main Fax